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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,818	01/28/2000	Mark Alperovich	85134-6200	2697

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WINSTON & STRAWN LLP  
1700 K STREET, N.W.  
WASHINGTON, DC 20006

EXAMINER
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ANGEBRANNDT, MARTIN J

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/493,818	<b>Applicant(s)</b> ALPEROVICH ET AL.	
	<b>Examiner</b> Martin J. Angebrannndt	<b>Art Unit</b> 1756	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☒ They raise the issue of new matter (see NOTE below);  
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
 6. ☒ Newly proposed or amended claim(s) 21-24 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: none.  
 Claim(s) objected to: 20.  
 Claim(s) rejected: 1-19 and 21-24.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
 13. ☐ Other: \_\_\_\_\_.

  
 Martin J. Angebrannndt  
 Primary Examiner  
 Art Unit: 1756

3/12/06

Continuation of 3. NOTE: The claims language currently describes the information layer as comprising a substrate, the fluorescent composition and the primer layer. The specification only describes the (fluorescent) dye in terms of the fluorescent composition coating solution. This position seems to be supported by the examples. .

Continuation of 5. Applicant's reply has overcome the following rejection(s): The terminal disclaimer filed obviates the double patenting rejections. .

Continuation of 11. does NOT place the application in condition for allowance because: The applicants arguments neglects the fact that Tamura et al. '792 teaches polymethine dyes of formula I or II, but these formulae do not embrace cyanine dyes. Consequently, any limitation on the amount of polymethine dyes does not limit the cyanine dyes of compound 201, which is not embraced by these formulae and cyanine dyes are expressly discussed as outside the bounds of formulae I and II in column 25 at lines 17-29. Therefore the Tamura et al. reference cannot be reasonably construed as a teachings away. Further, the claims use "comprising" language, which leaves the claims open to further constituents in the layer, which are not described by the recitation of the claims. The examiner agrees that Huh et al. teaches away from high concentrations of dyes and asserts that it combines well with Inagaki et al., the primary reference. Moreover Tamura et al. is cited for the teachings of the other components and their functionality in dye based recording media. The position of the examiner is that one of ordinary skill in the art would expect to realize the benefits ascribed to these additives to any dye based recording medium. The examiner notes that the examples in the instant specification do not support the position of the dried recording layer being having the recited dye content as in the examples the amounts within the scope of the ranges recited are present in the coating solutions. This is another reason it raises the issue of new matter. As the amendment was NOT entered, the position argued is divergent from the claimed invention. The applicant's position with respect to Sasakawa et al. misses the point. The examiner's position is that all of the references dry the dye based recording layers after they are applied from solution. Clearly, if heat can be used, the drying process will take place more quickly, but the temperature cannot be too high as the polymeric substrate will melt or deform. Sasakawa et al. supports the examiner's position that 100 degrees C is suitable, including for the case where PVC is used as the substrate material. The recitation of binders is similar to those of Inagaki et al. and the amounts recited are in the dried layer as the phthalocyanine and dye content can be as much as 100 % of the recording layers composition (7/24-25). Therefore the applicant is comparing two different states of the recording layer composition, the coating solution and the dried layer. The applicant argues that Suzuki '574 does not teach increasing the fluorescence signal. The applicant has no comparative data directly attributing an increase in the fluorescence signal to the diethylene glycol. As the ability to increase the dye content is disclosed by Suzuki '574, there is a basis for the fluorescence increasing as the concentration of fluorophores is increased. It does appear obvious that this would occur on the basis of the teachings of Suzuki '574. The rejections stand.

ME  
3/10/08